

REMARKS/ARGUMENT

Claims 20, 21 and 24-27 stand allowed.

1) Claims 15, 17, 19, 22-23, 28, 30-44 and 46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton PN 5,249,218 in view of Morris PN 5,020,090. Applicants respectfully traverse this rejection as set forth below.

Prior to addressing the technical aspects of the above rejection, Applicants respectfully traverse the Examiner's erroneous determination that "one cannot show nonobviousness by attacking references individually where the rejections are based on combination of references" (Office Action, page 3, lines 3-6).

Applicants respectfully point out Sainton individually and Morris individually are the prior art – NOT the COMBINATION of Sainton and Morris as suggested by the Examiner. Applicants respectfully point out that they are entitled to analyze the references individually first, and then in combination to determine what is the prior art.

In Graham v. John Deere Co., 148 USPQ 459 (U.S. Sup. Ct. 1966), the U.S. Supreme Court clearly and explicitly compared Scoggin's invention first to the Lohse patent individually, thereafter to the Mellon patent individually, and thereafter to the Livingstone patent individually. 148 USPQ 459, 472. **Such an individual assessment of the prior art references is considered well-settled law** in view of the fact that the obviousness statute, 35 USC 103, "refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102". Graham, 148 USPQ 459, 465-466 (quoting the Senate and House Reports, S. Rep. No. 1979, 82nd Cong., 2d Sess. (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess. (1952)). Thus, Graham **requires that each reference be assessed individually to ascertain how it differs from the claims.**

This should be clear by realizing that 35 USC 103 has as its predicate 35 USC 102. If the factual inquiry of ascertaining the differences between the prior art and the claims results in a finding that there are no differences between the prior art (e.g., any single reference) and the claims, then a rejection under 35 U.S.C. 102 would be proper without any necessity of a rejection under 35 USC 103. **Thus, when ascertaining differences between the prior art and the claims, each reference is to be taken individually as under 35 USC 102.**

Further, Applicants' arguments do in fact consider the effect of combining the references. In re Sernaker, 217 USPQ 1 (Fed. Cir. 1983), states well the test for determining whether the ascertained differences between the prior art and the claims are such that the claimed subject matter as a whole would have been obvious: "whether a combination of the teachings of all or any of the references would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of the invention". Thus, the teachings of the prior art are to be evaluated as a combined whole, but after the differences between the prior art and the claims have been ascertained. Both In re Keller, 208 USPQ2d 871, 880-881, and In re Merck & Co., 800 F.2c 1091, 231 USPQ 375 (Fed. Cir. 1986), relied on by the Examiner, assess the combined teachings of the prior art only after the differences between the prior art and claims had been determined.

Independent Claim 15 requires and positively recites a computer, comprising: "a provision for user input", "a provision for output", "a microprocessor coupled to said user input and said output" and "an interface coupled to said microprocessor, said interface **being directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto**, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said portable telephone".

Independent Claim 30 requires and positively recites, a **portable telephone**, comprising: “an input”, “an output”, “a microprocessor coupled to said input and said output” and “an interface coupled to said microprocessor, said interface **being directly connectable without a cable or tethered connection to a corresponding interface in another portable telephone**, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said another apparatus”.

Independent Claim 38 requires and positively recites, a method, comprising the steps of: “providing an input”, “providing an output”, “coupling a microprocessor to said input and said output” and “coupling an interface to said microprocessor, said interface **being directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto**, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said another apparatus”.

Independent Claim 43, as amended, requires and positively recites, a computer, comprising: “a provision for user input”, “a provision for output”, “a microprocessor coupled to said user input and said output” and “an interface coupled to said microprocessor, said interface being located within a cavity in said computer and **directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto**, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said portable telephone”.

Independent Claim 46, as amended, requires and positively recites, a computer, comprising: “a provision for user input”, “a provision for output”, “a microprocessor coupled to said user input and said output”, “an interface coupled to said microprocessor, said interface **being directly connectable without a cable or tethered connection to a corresponding interface** in a portable telephone **having a battery coupled thereto**” and “a mechanism on said computer that cooperates with a corresponding mechanism on said portable telephone for removably securing said portable telephone to said computer”.

In contrast, Sainton clearly discloses in Figure 3 that the connector (112) of modem (10) in computer (104)(the interface for computer 104) is coupled via a 3FT. black round cable (114) to a corresponding connector (118) in cellular phone (116). As a result, there is NO DIRECT CONNECTION WITHOUT A CABLE OR TETHER between connector (112) of computer (110) and connector (118) of cellular phone (116), or the suggestion of any direct connection between connector (112) of computer (110) and connector (118) of cellular phone (116). Applicants’ argument is confirmed by the Examiner’s agreement that Sainton “does not teach connecting the computer to the telephone without a cable or tethered connection” (Office Action dated September 29, 2005, page 4, lines 24-26).

As such, Sainton fails to teach or suggest, “a microprocessor coupled to said user input and said output” and “an interface coupled to said microprocessor, said interface **being directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto**, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said portable telephone”, as required by Claim 15, OR a **portable telephone**, comprising: “an interface coupled to said microprocessor, said interface **being directly connectable without a cable or tethered connection to a**

corresponding interface in another portable telephone, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface **in said another portable telephone**", as required by Claim 30, OR "coupling an interface to said microprocessor, said interface **being directly connectable without a cable or tethered connection to a corresponding interface in a portable telephone having a battery coupled thereto**, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said another apparatus", as required by Claim 38.

Similarly, Sainton fails to teach or suggest, "an interface coupled to said microprocessor, said interface being located within a cavity in said computer and **directly connectable without a cable or tethered connection to a corresponding interface** in a portable telephone **having a battery coupled thereto**, wherein said interface comprises at least one voice channel lead, one command channel lead and a ground/reference lead for connection to corresponding leads in a corresponding interface in said portable telephone", as required by Claim 43 OR "an interface coupled to said microprocessor, said interface **being directly connectable without a cable or tethered connection to a corresponding interface** in a portable telephone **having a battery coupled thereto**" and "a mechanism on said computer that cooperates with a corresponding mechanism on said portable telephone for removably securing said portable telephone to said computer", as required by Claim 46.

In order to overcome Sainton's failure to teach connecting a computer to a telephone without a cable or tethered connection, the Examiner relies upon Morris PN 5,020,090 as providing such teaching. Applicants respectfully traverse this determination, as set forth below.

Morris discloses an apparatus for removably connecting a cellular portable telephone to a laptop computer which comprises a track formed in the housing of the computer and is structured to slidably receive a cellular portable telephone **whose battery pack has been removed.**(Abstract, lines 1-6, col. 1, lines 46-49, figs. 1-3).

Morris specifically states:

Cellular portable telephone 38 is shown with the **battery pack (not shown) removed.** Cellular portable telephone 38 **slidably connects or mounts to the battery pack (not shown) in a manner similar to the way in which it connects or mounts to apparatus for removably connecting 10 incorporated into computer 22** (col. 3, lines 31-37)

As a result, Morris' cellular portable telephone 38 does have a battery pack for use of telephone 38 when it is not connected to computer 22, but the battery must be removed in order to connect it to computer 22 since the track mechanism on the phone which is used to secure the battery pack is the SAME track that is used to secure the phone to computer 22. Thus, and in contrast to the Examiner's determination (Office Action, page 2, lines 12-16), Morris does have a battery pack, but it must be removed to secure the phone to the computer. As such, the battery pack and the computer 22's interface are mutually exclusive connections for portable telephone 38.

Thus, assuming, arguendo, that one having ordinary skill in the art at the time of Applicants' invention would have combined Sainton and Morris, the resulting device would still not obviate the present invention since the only way that a portable telephone could be coupled to the computer in a manner such that the corresponding interfaces are directly connected, is when the battery is removed from the portable telephone.

In proceedings before the Patent and Trademark Office, "the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art". In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). "The Examiner can satisfy this

burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”, In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992)(citing In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)(citing In re Lahu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). While the Examiner has provided a subject rationale for the combination of Sainton and Morris, he has provided no objective teaching in the prior or knowledge generally available to one having ordinary skill in that art that would lead that individual to combine the relevant teachings of Sainton and Morris, without the improper hindsight provided by Applicants’ disclosure.

Similarly, even if, arguendo, all of the limitations of Claims 15, 30, 38, 43 and 46 were to be present when Sainton and Morris are combined, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, **absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined ONLY if there is some suggestion or incentive to do so.**" ACS Hosp. Systems, Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Further, the Examiner has proposed a “modification” to the combination of Sainton and Morris. More specifically, that one having ordinary skill in the art would modify the track mechanism to be outside Morris’ phone 38 so that it will still somehow attach to computer 22 even with the battery pack on. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. **The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.** In re Gordon, 733 F.2d at 902, 221 USPQ at 1127. Moreover, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the

teachings of the prior art so that the claimed invention is rendered obvious. In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). See also Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed.Cir.1985). The Examiner proposes modifications to the resulting combination of Sainton and Morris without any teaching or suggestion from the prior art. Accordingly, the Examiner has not set forth a prima facie case of the obviousness of Claims 15, 30, 38, 43 and 46 and his rejection is not complied with relevant law. Accordingly, the 35 U.S.C. 103(a) rejection of Claims 15, 30, 38, 43 and 46 is overcome.

Claims 17, 19, 22-23 and 28 stand allowable as depending directly, or indirectly, from allowable independent Claim 15 and including further limitations not taught or suggested by the references of record. Claims 31-37 stand allowable as depending directly, or indirectly, from allowable independent Claim 30 and including further limitations not taught or suggested by the references of record. Claim 44 stands allowable as depending directly from allowable independent Claim 43 and including a further limitation not taught or suggested by the references of record.

Claim 17 further defines the computer of Claim 15, wherein said at least one command channel lead facilitates a bidirectional half duplex mode. Claim 17 is allowable for the reasons set forth in support of the allowance of Claim 15. Moreover, Sainton and Morris, alone or in combination, fail to Claim 17's additional limitation of "wherein said at least one command channel lead facilitates a bidirectional half duplex mode".

Claim 19 further defines the computer of Claim 15, wherein voice and data are transmitted on said at least one voice channel lead. Claim 19 is allowable for the reasons set forth in support of the allowance of Claim 15. Moreover, Sainton and Morris, alone or in combination, do NOT teach or suggest that its voice channel can be used for Data & Audio.

Indeed, Sainton teaches data on the DIO/DATA line and audio on the TX/TXAF and possibly RX/SPK lines.

Claim 22 further defines the computer of Claim 15, wherein said interface coupled to said microprocessor further includes a second voice channel lead. Claim 22 is allowable for the reasons set forth in support of the allowance of Claim 15. Moreover, Sainton and Morris, alone or in combination, do NOT teach or suggest Claim 22's additional limitation of "wherein said interface coupled to said microprocessor further includes a second voice channel lead".

Claim 23 further defines the computer of Claim 22, wherein each of said voice channel leads facilitates a unidirectional full duplex mode. Claim 23 is allowable for the reasons set forth in support of the allowance of Claim 22. Moreover, Sainton and Morris, alone or in combination, do NOT teach or suggest Claim 23's additional limitation of "wherein each of said voice channel leads facilitates a unidirectional full duplex mode".

Claim 28 further defines the computer of Claim 23, wherein voice and data are transmitted on said voice channel leads. Claim 28 is allowable for the reasons set forth in support of the allowance of Claim 23. Moreover, Sainton and Morris, alone or in combination, do NOT teach or suggest Claim 28's additional limitation of "wherein voice and data are transmitted on said voice channel leads".

Claim 31 further defines the apparatus of Claim 30 by further including one of a keypad and keyboard coupled to said input. Claim 31 is allowable for the reasons set forth in support of the allowance of Claim 30.

Claim 32 further defines the apparatus of Claim 30 by further including a display coupled to said output. Claim 32 is allowable for the reasons set forth in support of the allowance of Claim 30.

Claims 33-37 have been canceled. As such, the corresponding rejections are moot.

Claims 39-42 have been canceled. As such, the corresponding rejections are moot.

Claim 44 further defines the apparatus of Claim 43 wherein said portable telephone fits at least partially within said cavity when directly connected to said interface. Claim 44 is allowable for the reasons set forth in support of the allowance of Claim 43.

2) Claim 16 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton PN 5,249,218 in view of Morris PN 5,020,090 as applied to Claim 15 above, and further in view of Kyu et al PN 4,225,919. Applicants respectfully traverse this rejection as set forth below.

Claim 16 depends from Claim 15 and is therefore allowable for the same reasons set forth above in support of the allowance of Claim 15. To the extent Claim 16 adds an additional limitation, it further defines the computer of Claim 15, wherein said at least one voice channel lead facilitates a bidirectional half duplex mode.

Even if, *arguendo*, Kyu et al teaches two basic types of data links are well known, including both bidirectional half-duplex and unidirectional full-duplex, as suggested by the Examiner, Kyu does not provide any teaching that overcomes the previously described deficiencies of the Sainton and Morris references. For this reason alone, Claim 16 is allowable over this combination of references. Even if such were not to be the case, the Examiner has pointed to nothing in Kyu that teaches or suggest “wherein said **at least one voice channel lead facilitates** a bidirectional half duplex mode”. As a result, the 35 U.S.C. 103(a) rejection is overcome.

3) Claim 18 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton PN 5,249,218 in view of Morris PN 5,020,090 as applied to Claim 15 above, and further in view of Dent et al PN 5,581,597. Applicants respectfully traverse this rejection as set forth below.

Claim 18 further defines the computer of Claim 15, wherein said interface coupled to said microprocessor further includes a power lead. To the extent Claim 18 adds an additional limitation, it further defines the computer of Claim 15, wherein the interface coupled to the microprocessor further includes a power lead.

Even if, *arguendo*, Dent et al teaches a cellular terminal that is powered by an external signal line while the cellular terminal is parked, as suggested by the Examiner, Dent does not provide any teaching that overcomes the previously described deficiencies of the Sainton and Morris references. For this reason alone, Claim 18 is allowable over this combination of references. Even if such were not to be the case, one having ordinary skill in the art would not have been led to include a power signal “since this would have allowed for recharging the cell phone”, as suggested by the Examiner, since Morris specifically requires that the battery in portable phone 38 be removed while portable phone 38 is connected to computer 22 – thus there is no possibility of the battery being “recharged”. As a result, the 35 U.S.C. 103(a) rejection is overcome.

4) Claim 45 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Sainton PN 5,249,218 in view of Morris PN 5,020,090 as applied to Claim 43 above, and further in view of Kobayashi PN 5,111,361. Applicants respectfully traverse this rejection as set forth below.

Claim 45 further defines the computer of Claim 43, wherein said portable telephone fits completely within said cavity when directly connected to said interface. To the extent Claim 45 adds an additional limitation, it further defines the computer of Claim 15, wherein said portable telephone fits completely within said cavity when directly connected to said interface.

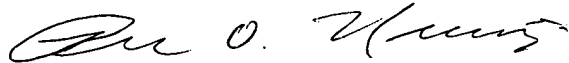
Even if, arguendo, Kobayashi teaches a notebook computer in which the battery pack fits completely within a cavity for holding the battery pack, Kobayashi does not provide any teaching that overcomes the previously described deficiencies of the Sainton and Morris references. For this reason alone, Claim 45 is allowable over this combination of references. Further, even if such were not to be the case, one having ordinary skill in the art would not have been led to conclude that just because Kobayashi teaches a notebook computer in which the battery pack fits completely within a cavity for holding the battery pack, it would therefore be obvious to ALSO fit a separate portable telephone completely within the surface of Kobayashi's notebook computer. The Examiner's purported motivation for the combination "i.e., that it would be "aesthetically pleasing" is pure supposition not supported by fact. Being that the internal space within notebook computers is at a premium and no space is wasted, what circuitry or sub-systems in Kobayashi does the Examiner propose to remove in order to make room for an entire portable telephone? Moreover, **it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.** Accordingly, the 35 U.S.C. 103(a) rejection is overcome.

An amendment after a final rejection should be entered when it will place the case either in condition for allowance or in better form for appeal. 37 C.F.R. 1.116; MPEP 714.12. This amendment places the case in condition for allowance. At a minimum, this amendment places the case in better form for appeal since it reduces the number of issues

on appeal by reducing the total number of appeal able claims 25 to 16. No new matter is introduced by this amendment. Claim 30 has been amended to include limitations from several of its dependent claims. Claims 15 and 38 have been amended to include the limitation wherein the portable telephone "has a battery coupled thereto". All of these issues have been previously before the Examiner.

Claims 20, 21 and 24-27 are allowed. Claims 15-19, 22-23, 28, 30-32, 38 and 43-46 stand allowable over the references of record. Applicants respectfully request allowance of the application as the earliest possible date.

Respectfully submitted,



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